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APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,178	01/31/2002	Johann F. Hellenkamp	1.096.01	9383

7590 07/11/2006  
MALLOY & MALLOY, P.A.  
2800 S.W. Third Avenue  
Historic Coral Way  
Miami, FL 33129

EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/062,178

Applicant(s)

HELLENKAMP, JOHANN F.

Examiner

Michael Thaler

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-24 is/are allowed.
- 6) ☒ Claim(s) 25-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/4/06, 4/3/06.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3731

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on Jan. 4, 2006 has been entered.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 25-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,527,788, claims 1-5 of U.S. Patent No. 6,296,649, claims 1-5 of U.S. Patent No. 6,132,446 and claims 1-53 of U.S. Patent No. 5,624,456. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious that the cutting blade recited in the patent claims is shaped as to avoid interference with movement of the cutting head.

Claims 25-37 are otherwise allowable.

Claims 2-24 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

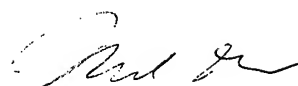
Application/Control Number: 10/062,178

Page 4

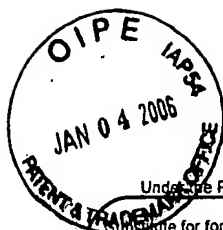
Art Unit: 3731

mht

6/28/06



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731



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PTO/SB/08B (07-05)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

<b>FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)		<b>Complete if Known</b>	
		Application Number	10/062,178
		Filing Date	January 31, 2002
		First Named Inventor	Johann F. Hellenkamp
		Art Unit	3731
Examiner Name	Thaler, Michael H.		
Attorney Docket Number	1.096.01		
Sheet 1	of 2		

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
JH	1	PHOENIX KERATEK, INC., "The Solution", Advertisement, Bate Stamp No. KOEPNICK000073	
	2	PHOENIX BIOMEDICAL, INC., "Check Us Out!", Advertisement, Bate Stamp No. KOEPNICK000087	
	3	PHOENIX BIOMEDICAL, INC., "Universal Keratome Model 1000", Advertisement, Bate Stamp No. KOEPNICK000088	
	4	PHOENIX KERATEK, INC., Product Brochure, Bate Stamp Nos. KOEPNICK000089 - KOEPNICK000095	
	5	BINDER, ET AL., "Comparison of the UniversalKeratome and the Automated Corneal Shaper," J CATARACT REFRACT SURG-VOL 22, Nov1996, Bate Stamp Nos. KOEPNICK000096-KOEPNICK000107 (missing pp. 1186 and 1187)	
	6	BINDER, Video Presentation, Bate Stamp Nos. KOEPNICK000108 - KOEPNICK000130	
	7	UPDEGRAFF, "Exploring Microkeratome Evolution and Design", Vision Surgery & Laser Ct., pp. 7-9, Bate Stamp Nos. KOEPNICK000133 - KOEPNICK000135	
	8	KRONEMYER, "Advanced Microkeratome Simplifies ALK", Ocular Surgery News; Bate Stamp No. KOEPNICK000136	
	9	"News & Trends", Review of Ophthalmology, December 1995, Bate Stamp Nos. KOEPNICK000137 - KOEPNICK000139	
	10	SCHNEIDER, "Eye Device Hits Market", Arizona Business Gazette, Vol 116, No. 5, Week of Feb. 1-7, 1996, pp. 1 and 15, Bate Stamp Nos. KOEPNICK000140 - KOEPNICK000141	

Examiner Signature		Date Considered	6-28-06
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.


<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

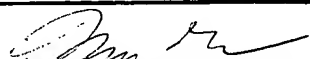
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Substitute for form 1449/PTO <b>FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use as many sheets as necessary)		<b>Complete if Known</b>	
		Application Number	10/062,178
		Filing Date	January 31, 2002
		First Named Inventor	Johann F. Hellenkamp
		Art Unit	3731
		Examiner Name	Thaler, Michael H.
Sheet 2	of 2	Attorney Docket Number	1.096.01

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Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	11	BINDER, "Comparing Keratomileusis in Situ and Excimer Laser Assisted Keratomileusis in Situ", Refractive Business Advisor, April/May 1996, Bate Stamp Nos. KOEPNICK000142-145	
	12	LITTLEFIELD, ET AL., "New Method for Reshaping the Cornea", Journal of Biomedical Optics, Vol. 2, No.1, pp. 106-114, January 1997, KOEPNICK000147-KOEPNICK000156	
	13	KRONEMYER, "Advanced Microkeratome Simplifies ALK", Ocular Surgery News, January 1996, Bate Stamp Nos. KOEPNICK000157 - KOEPNICK000159	
	14	LIPNER, "Microkeratomes: Exploring Current Technology", Eye World, October 1996, pp. 39-40, Bate Stamp Nos. KOEPNICK000160 - KOEPNICK000161	
	15	SINGER, "1998 Guide to Microkeratomes - Demand Drives Growth in Microkeratome Market", Bate Stamp Nos. KOEPNICK000162 - KOEPNICK000164	
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Examiner Signature		Date Considered	6-28-06
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Sheet	1	of	1
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PTQ/SB/08A (07-05)

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**Complete if Known**

Application Number	10/062,178
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First Named Inventor	Johann F. Hellenkamp
Art Unit	3731
Examiner Name	Thaler, Michael H.
Attorney Docket Number	1.096.01

## U. S. PATENT DOCUMENTS

**FOREIGN PATENT DOCUMENTS**

Examiner Signature		Date Considered	6-28-06
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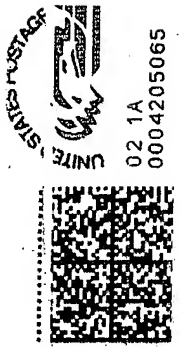
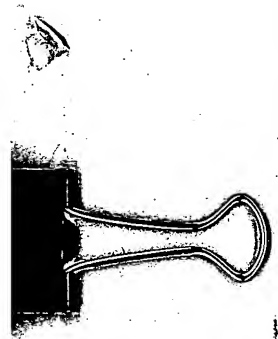
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